

Appl. No. 10/067,185
Amdt. dated Oct. 29, 2003
Reply to Office action of September 29, 2003

REMARKS/ARGUMENTS

1. Responsive to the Office action dated 09/29/03, applicant provisionally elects the invention of Group I, which includes the invention of originally presented claims 1, 15, 22-24 and 35-39, that of currently amended claims 7, 14 and 18 and that of new claims 40-44. Applicant respectfully traverses the restriction requirement and requests reconsideration and withdrawal of the requirement for the reasons given below.

The invention of proposed Group I (claims 1, 22-24 and 35-39) should not be classified in class 435, subclass 254.6 because that class and subclass are appropriate only for compositions wherein the fungus is "altered" which is not the case for "*Trichoderma virens* GL-3 (ATCC 58678)." An appropriate classification would be in class 424 or class 504. Both of these classes include compositions, processes for making the compositions and processes for using the compositions.

The invention of proposed Group II (claim 2) should not be classified in class 435, subclass 252.5 because the subject matter is not "Subject matter wherein the microorganism is a species of *Bacillus*." The claimed compositions of Group I also contain such a microorganism. An appropriate class and subclass would be that chosen for proposed Group I.

The invention of proposed Group III (claim 3) should not be classified in class 435, subclass 410 because the subject matter is not “Subject matter which includes plant cells or cell lines, per se which may be transgenic, mutant, or products of other processes for obtaining plant cells; compositions containing plant cells; processes of in vitro propagating, maintaining or preserving plant cells or cell lines; processes of isolating or separating plant cells; processes of regenerating plant cells into tissues, plant parts, or plants, per se, wherein no genotypic change occurs; and medium for propagation, maintenance, preservation, etc. of plant cells or cell lines.” There is no mention of plant cells or cell lines in the claim. An appropriate class and subclass would be that chosen for proposed Group I.

The invention of proposed Group IV (claims 4-9, 14-17 and 21) should not be classified in class 424, subclass 406 because the subject matter is not “Subject matter in which the composition includes a component for reducing the toxic effects of the composition on insects, animals or plants that are not the target of the biocidal composition.” An appropriate class and subclass would be that chosen for proposed Group I. Moreover, the invention of claims 14-17 are in or linked to the invention of Group I because claims 14-17 are now linked to claim 1 which is in proposed Group I.

The invention of proposed Group V (claims 10, 13, and 18-19) should not be classified in class 424, subclass 405 because the subject matter is not “Subject matter in which the composition having a special physical form is claimed or disclosed as biocidal or repellent or attractant to animals or insects.” The invention has nothing to do with animals and insects. An appropriate class and subclass would be that chosen for proposed Group I. Moreover, the

invention of claims 13 and 18 are in or linked to the invention of Group I because claims 13 and 18 are linked to claim 1 which is in proposed Group I.

The invention of proposed Group VI (claims 11-12 and 20) should not be classified in class 424, subclass 195.15 because the subject matter is not “Subject matter wherein the active ingredient is a material or an extract obtained from a multicellular fungus. The claims are process claims, not claims for an “extract or material containing or obtained from a multicellular fungus as active ingredient” as required by the definition of the proposed subclass. An appropriate class and subclass would be that chosen for proposed Group I.

The invention of proposed Group VII (claims 25-28) should not be classified in class 435, subclass 415 because the subject matter is not “Subject matter wherein the plant cell or cell line is from a soybean plant.” There is no recitation of a “plant cell or cell line” in the claims. The seed portion of the composition may be a soybean plant seed, but need not be. An appropriate class and subclass would be that chosen for proposed Group I.

The invention of proposed Group VIII (claims 29-32) should not be classified in class 435, subclass 420 because the subject matter is not “Subject matter directed to the processes of culturing, propagating, maintaining, preserving, or regenerating of plant cells or cell lines.’ The invention has nothing to do with plant cells or cell lines. An appropriate class and subclass would be that chosen for proposed Group I. Moreover, the invention of claims 29-32 are linked to the invention of proposed Group I because claims 29-32 are linked to claim 23 which is in proposed Group I.

The invention of proposed Group IX (claims 33-34) should not be classified in class 424, subclass 780 because the subject matter is not “Subject matter wherein the active ingredient is a material or an extract obtained from a micro-organism.” The claims are process claims, not claims for an “extract or material containing or obtained from a micro-organism as active ingredient” as required by the definition of the proposed subclass. An appropriate class and subclass would be that chosen for proposed Group I.

2. The methods of proposed Groups IV and V are processes of using the products of proposed Groups I and II. MPEP 806.05(h) requires that “a product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.” It is not true that “materially different products could be used in the methods such a imazalil and/or epoxiconazole.” These products are chemical fungicides that are not mentioned in the specification or in the claims. The processes as claimed require the presence of a fungal antagonist that might be killed by a chemical fungicide other than those mentioned in the specification or claims, rendering the inventions of Groups I and II less effective or ineffective. The Examiner has not provided evidence that the proposed combination would work. Moreover, it excludes features of the claimed invention. Therefore, the processes of Groups IV and V (as claimed) cannot be practiced with a materially different product.

3. The methods of proposed Groups VI and IX are processes of making the products of proposed Groups I and II. Claim 34 is a process of making and using the product. MPEP 806.05(f) requires that “a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.” In all claimed inventions in Groups VI and IX, the compositions are “made by combining after being cultured alone.” In claims 11, 12 and 34, the components of the product are “essentially pure” cultures and the combinations claimed are made by combining after being cultured alone at one point. In claims 20 and 35, strains which may be cultured alone are combined. Therefore, the products of Groups I and II (as claimed) cannot be made by a materially different process.

All of the claimed inventions are connected in design, operation and effect. In design, all of the inventions other than the invention of claim 38 involve combining a spore-forming fungal antagonist and a spore-forming bacterial antagonist. In operation, all of the inventions other than the invention of claim 38 involve using a composition comprising a spore-forming fungal antagonist and a spore-forming bacterial antagonist. In effect, all of the inventions other than the invention of claim 38 involve controlling plant pathogens or increasing plant yield with a spore-forming fungal antagonist and a spore-forming bacterial antagonist.

For the above reasons, the classification of the claimed inventions is the same, the field of search is the same and there is no clear indication of separate future classification and field of

search. Thus, independent searches are not required and restriction is not appropriate in this case and examination of all of the claims is respectfully requested.

Linking claims 13, 18, 19 and 44 link proposed Group V to proposed Group I. Linking claims 7, 8, 14, 15, 16, 17 and 41 link proposed Group IV to proposed Group I. Linking claims 29-32 link proposed Group VIII to proposed Group I. Linking claim 40 links proposed Group VI to proposed Group I. Linking claim 42 links proposed Group IX to proposed Group I. Linking claim 43 links proposed Group II to proposed Group I. MPEP 808 requires that “The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn.”

Claims 7, 14 and 18 were amended to place them in Group I or to link them to Group I. Claim 20 was amended to eliminate a typographical error. New claims 40-44 depend from previously presented independent claims in proposed Group I and are patentable because the independent claims from which they depend are patentable.

A Credit Card Payment form is enclosed.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required during the entire pendency of this application to Deposit Account No. 500593.

Respectfully submitted,

ROBERT M. HUNTER PLLC

By: Robert M. Hunter

Robert M. Hunter
Reg. No. 42,679
Tel.: (808) 885-4194